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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/183,789 10/30/98 MARTELANGE

V L0461/7047

EXAMINER

HM12/0215

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HARRIS, A

PAPER NUMBER

1642  
DATE MAILED:

9  
02/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/183,789

Applicant(s)

Marélange et al.

Examiner  
Alana M. Harris, Ph. D.

Group Art Unit  
1642



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1, 8, 9, 18-20, 24, 28, 35, 38, 40, 41, 43, 45, 47, and 50 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1, 8, 9, 18-20, 24, 28, 35, 38, 40, 41, 43, 45, 47, and 50 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 8, 9, 18, 19, 40, 41 and 43, drawn to an isolated nucleic acid, classified in class 536, subclass 23.1.
  - II. Claim 20, drawn to an isolated polypeptide, classified in class 530, subclass 350.
  - III. Claim 24, drawn to an antibody, classified in class 530, subclass 387.1.
  - IV. Claim 28, drawn to a method of diagnosing a disorder that is DNA hybridization based, classified in class 435, subclass 6.
  - V. Claim 35, drawn to a method of diagnosing a disorder that is antibody based, classified in class 435, subclass 7.1.
  - VI. Claim 38, drawn to a method of treating comprising administering an effective amount of an agent, classified in class 514, subclass 2.
  - VII. Claim 45, drawn to a method for treating comprising administering an agent which enriches complexes, classified in class 514, subclass 2.
  - VIII. Claim 47, drawn to a method for treating a subject having a condition comprising introducing cytolytic T cells, classified in class 514, subclass 93.1.
  - IX. Claim 50, drawn to a method for producing a tumor associated polypeptide, classified in class 435, subclass 69.1.
2. The inventions are distinct, each from the other because of the following reasons:

Art Unit:

Groups I-III are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups IV-IX differ in the method objectives, method steps and parameters and in the reagents used.

Inventions of Groups I and Groups IV, VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid of Group I can also be used in all three methods of Groups IV, VIII and IX.

Inventions of Groups III and Groups V-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group III can also be used in all three methods of Groups V-VII.

Art Unit:

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
5. Attempts to reach John R. VanAmsterdam by telephone on February 9, 1999 to request an oral election to the above restriction requirement were unsuccessful.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, whose telephone number is (703) 306-5880.

  
PAULA K. HOTZELL  
SUPERVISORY PATENT EXAMINER